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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,093	03/26/2004	Steven Davis	20114/00101	9722
7590 05/25/2010				
Fay Kaplun & Marcin, LLP Suite 702 150 Broadway New York, NY 10038			EXAMINER ANDERSON, JOHN A	
			ART UNIT 3694	PAPER NUMBER
			MAIL DATE 05/25/2010	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/811,093

**Applicant(s)**

DAVIS ET AL.

**Examiner**

JOHN A. ANDERSON

**Art Unit**

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. In the amendment filed 10/26/2009, claims 1-21 are pending and are presented for examination.

***Information Disclosure Statement***

2. The information disclosure statement dated 08/12/2004 has been considered.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-12 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

4. Based on Supreme Court precedent (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, §101 process must (1) be tied to a

particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (the Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)).

5. If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. §101.
6. In this particular case, regarding the first test, in performing the steps of the claimed subject matter, there is no requirement that a machine be used, thus the claims are not considered sufficiently tied to a particular machine. Regarding the second test, since the claimed subject matter may be performed using only human intelligence, the steps do not sufficiently transform the underlying subject matter to be statutory. Thus, to qualify as a 101 statutory method, the claim should positively recite the other statutory class (the thing or product) to which it is tied and sufficiently transform the underlying subject matter. Appropriate correction is required

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
  1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
9. Claims 1-12,16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn J P et al (PGPub 2005/0171899) and in view of Cordery R A et al (US PGPub No.:2005/0108167).

10. As regards claim 1, Dunn J.P. discloses a method, comprising the steps of:

- scanning each of a plurality of checks to generate digitized images thereof, the plurality of checks including at least one of non-consumer checks and consumer checks;[0058]
- generating a master file including a record for each check, each record including the digitized image of the corresponding check and a data portion including data obtained from a MICR line of the corresponding check;[0092]

Dunn J P et al does not disclose sorting the records into first and second sub-files as a function of at least one of the digitized images and the data portions, the first sub-file including only the non- consumer checks and the second sub-file including only the consumer checks;

- processing the records included in the first sub-file according to a non-consumer check procedure to settle transactions referenced by each of the checks corresponding to the records in the first sub-file; and
- processing the records included in the second sub-file according to one of a consumer check procedure and a non- consumer check

procedure to set transactions referenced by each of the checks corresponding to the records in the second sub-file.

Cordery R A et al discloses sorting the records into first and second sub-files as a function of at least one of the digitized images and the data portions, the first sub-file including only the non- consumer checks and the second sub-file including only the consumer checks;

- processing the records included in the first sub-file according to a non-consumer check procedure to settle transactions referenced by each of the checks corresponding to the records in the first sub-file; and
- processing the records included in the second sub-file according to one of a consumer check procedure and a non- consumer check procedure to set transactions referenced by each of the checks corresponding to the records in the second sub-file. [0018]

It would have been obvious for a person of ordinary skill in the art at the time of the invention was made to use Cordery R A et al in the device of Dunn J P et al. The motivation would have been to distinguish payee, business, merchants, corporate checks from payor, personal, consumer, and other debtor checks .

11. As regards claim 2, Dunn J.P. discloses wherein the first and second sub-files are processed separately. [0091]
12. As regards claim 3, Dunn J.P. discloses wherein the digitized images of the checks include images of at least one of a front and a rear of the checks. [0082]
13. As regards claim 4, Dunn J.P. discloses wherein the data portion further includes an amount of the check derived from the corresponding digitized image. [0063]
14. As regards claims 5 and 19, Dunn J.P. discloses further comprising the step of verifying the sorting step using information stored in a database of debtors. [0082]
15. As regards claim 8, Dunn J.P. discloses further comprising the step of: storing the data portion of each of the records in a database, the database being organized by debtors and each of the records corresponding to one of the debtors. [0066]
16. As regards claim 9, Dunn J.P. discloses wherein the database includes one of a debtor's name, a debtor's account number, a debtor's address, a debtor's ABA number, and a debtor's account payable amount. [0086]



17. As regards claim 10, Dunn J.P. discloses wherein the consumer check procedure includes processing of the second sub-file to forward it to a clearing network for a settlement. [0073]
18. As regards claim 11, Dunn J.P. does not disclose wherein the non-consumer check procedure includes electronically submitting the first sub-file to a financial institution, the financial institution generating an image replacement document for each of the non-consumer checks and submitting the image replacement document for a settlement. [0073]
19. As regards claim 12, Dunn J.P. discloses wherein the non-consumer check procedure includes electronically submitting the first sub-file to a first financial institution, the first financial institution forwarding the first sub-file to a second financial institution for settlement. [0073]
20. As regards claim 16, Dunn J.P. discloses a system for depositing checks, comprising:
  - a database storing information corresponding to debtors;[0066]
  - a master file including a set of records for a plurality of checks received from the debtors, each record corresponding to at least one of the checks, each record including a digitized image of the corresponding check and data obtained from a MICR line of the corresponding check, [0092]

- a first subfile including a first subset of the records, the first subset including records corresponding to checks categorized as non-consumer checks; and [0073]
- a second subfile including a second subset of the records, the second subset including records corresponding to checks categorized as consumer checks. [0073]

Dunn J P et al does not disclose wherein each record is categorized as corresponding to one of a non- consumer check and a consumer check, the categorization being a function of at least one of the digitized image, the data and the information in the database.

Cordery R A et al discloses wherein each record is categorized as corresponding to one of a non- consumer check and a consumer check, the categorization being a function of at least one of the digitized image, the data and the information in the database.[0018]

It would have been obvious for a person of ordinary skill in the art at the time of the invention was made to use Cordery R A et al in the device of Dunn J P et al. The motivation would have been to distinguish payee, business, merchants, corporate checks from payor, personal, consumer, and other debtor checks .

21. As regards claim 17, Dunn J.P. discloses wherein the records included in the first subfile are processed according to a non-consumer check procedure to settle

transactions referenced by each of the checks corresponding to the records in the first subfile. [0073]

22. As regards claim 18, Dunn J.P. discloses wherein the records included in the second subfile are processed according to a consumer check procedure to settle transactions referenced by each of the checks corresponding to the records in the second subfile. [0073]
23. As regards claim 20, Dunn J.P. discloses wherein the records of the master file are displayed to a user. [0146]
24. As regards claim 21, Dunn J.P. discloses wherein the database is updated using the data obtained from the check. [0086]
25. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn J P et al (PGPub 2005/0171899) and in view of Cordery R A et al (US PGPub No.:2005/0108167) and in further view Stoutenburg et al (US PGPub No.:2007/0029376)
26. As regards claim 6, Dunn does not disclose further comprising the step of: displaying each of the records in the master file, the display including one of the data portion, a snippet of the digitized image, a digital amount of the check and a categorization of the check.

Stoutenburg discloses further comprising the step of "displaying each of the records in the master file, the display including one of the data, portion, a snippet of the digitized image, a digital amount of the check and a categorization of the check; [0190, Upon receiving the approval, it is displayed on display 210 and/or display 252 and the value associated with the check is provided to the customer (block 860). Providing such value can include having the merchant disperse the value from an available cash register or other source, or in some embodiments, providing the value directly from POS device 130 via a cash dispersal mechanism].

It would have been obvious for a person of ordinary skill in the art at the time of the invention was made to use Stoutenburg in the device of Dunn. The motivation would have been to verify the accuracy of the data entered in the computer.

27. As regards claim 7, Dunn does not disclose wherein a user is permitted to alter the displayed record.

Stoutenburg discloses wherein a user is permitted to alter the displayed record. [0061, In such an embodiment, display reader interface 248 provides an interface for receiving input via the touch-screen.]

It would have been obvious for a person of ordinary skill in the art at the time of the invention was made to use Stoutenburg in the device of Dunn. The motivation would have been to update data that is not current.

28. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stoutenburg et al (US PGPub No. :2007/0029376) and in view of Cordery R A et al (US PGPub No.:2005/0108167
29. As regards claim 13, Stoutenburg discloses an image capturing device configured to capture a digitized image of a check, [0099, In some embodiments, display 252 supports electronic signature capture to facilitate processing of electronic forms of payment. In such embodiments, display 252 comprises a digitizer having at least eight-bit AID conversion detail]. Stoutenburg does not disclose a processor configured to extract data from the digitized image of the check and further configured to categorize the check as at least one of a non- consumer check and a consumer check as a function of at least one of the digitized image and the extracted data, wherein the processor stores the digitized 'image and the data in a first file when the check is categorized as a non-consumer check and in a second file when the check. Cordery R A et al discloses a processor configured to extract data from the digitized image of the check and further configured to categorize the check as at least one of a non- consumer check and a consumer check as a function of at least one of the digitized image and the extracted data, wherein the processor stores the digitized 'image and the data in a first file when the check is categorized as a non-consumer check and in a second file when the check

It would have been obvious for a person of ordinary skill in the art at the time of the invention was made to use Cordery R A et al in the device of Stoutenburg et al . The motivation would have been to distinguish payee, business, merchants, corporate checks from payor, personal, consumer, and other debtor checks .

30. As regards claim 14, Stoutenburg discloses wherein the digitized image includes a MICR line from which the data is extracted. [0039, it is scanned by the imager and MICR reader for content.]
31. As regards claim 15, Stoutenburg discloses wherein the processor categorizes the check based on the position of the data on the MICR line. [0235, In some embodiments, account information, and institution information derived by the MICR reader from the check is transferred from POS device 130 to checking host 1610. In turn, checking host 1610 compares the account and institution information against a list of known bad and/or suspicious accounts. Thus, where comparison of the information indicates that the check is either bad, or possible bad, authorization can be denied.]

### ***Response to Arguments***

Applicant's arguments see Remarks filed 02/19/2010, with respect to claims 1-

21 have been fully considered and are persuasive. The USC 102 rejections of claims 1-21 have been withdrawn.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN A. ANDERSON whose telephone number is (571)270-3327. The examiner can normally be reached on Monday through Friday 8:00 to 5:00 Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John A Anderson/

Examiner, Art Unit 3694

John A Anderson

Examiner

Art Unit 3694

/James P Trammell/

Supervisory Patent Examiner, Art Unit 3694

/J. A. A./

Examiner, Art Unit 3694